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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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08/477,855 06/07/95 TAHARA K 450100-2952.

DTM-1 EXAMINER

26M2/0821

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| ART UNIT | PAPER NUMBER |
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2615

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DATE MAILED:

08/21/96

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

| | |
|--------------------------------------|--------------------------------------|
| Application No. 08/477,855 | Applicant(s) Tahara et al. |
| Examiner Luanne Din | Group Art Unit 2615 |

Responsive to communication(s) filed on Feb 26, 1996

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

Claim(s) 1-23 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

Claim(s) 1-23 is/are rejected.

Claim(s) _____ is/are objected to.

Claims _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is approved disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) _____.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Part III DETAILED ACTION

1. Claims 1-23 are rejected as being non-statutory under 35 U.S.C. 101 because they seek undue extension of monopoly timewise of patent rights of applicant's United States patent No.

5,473,380. See In re Vogel and Vogel, 164 USPQ 619, 622; In re Schneller, 158 USPQ 210, 214. A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

For example, claims 1-3 are claiming the same apparatus as U.S. Patent No. 5,473,380 claims 1-4. Although the wording may be different from claim to claim. However, over all, the claimed invention is the same as patented invention. Claims 1-3 specify an apparatus for processing a digital signal including an identification area. U.S. Patent No. 5,473,380 claims 1-4 also specify an apparatus for processing a digital picture signal (claims 1 and 4) and means for receiving picture type signal included in the picture signal (claim 1). The picture type data is considered the identification data of a digital picture signal which is included in the digital picture signal.

2. The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy

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reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-23 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 5,437,380 in view of Kato (5,543,847).

Claims 1-5 and 11-15 of U.S. Patent No. 5,473,380 discloses substantially the same method and apparatus for processing a digital picture signal comprising a means for receiving picture type signal, coding means for encoding the picture signal including the motion vector detection means, means for separating

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and encoding according to picture type of the picture signal as specified in claims 1-3, 5-7, 13-15, and 17-19. Claims 6-10 and 16-20 of U.S. Patent No. 5,473,380 discloses substantially the same apparatus and method for processing an encoded digital signal comprising means for decoding encoded digital signal includes variable length decoding means and means for including picture type data as specified in claims 8, 10-12, 20, 22, and 23. Although U.S. Patent No. 5,473,380 does not particularly disclose the picture type data identifies an encoding structure of a group of picture as specified in claims 4, 9, 16, and 21.

Kato discloses substantially the same picture coding and decoding apparatus and method (Fig. 4 and 5, col. 3, line 63 to col. 4, line 39) wherein the picture type data identifies an encoding structure of a group of pictures represented by the digital picture signal and further identifies each respective picture within said group of pictures.

Therefore, it is considered obvious for one of ordinary skill in the art, having the teaching of using the picture type data identifies an encoding structure of a group of pictures represented by the digital picture signal and further identifies each respective picture within said group of pictures as shown by Kato, one can add the signal processing method of Kato to the signal processing of U.S. Patent No. 5,473,380 so that the picture type data can be identified as an encoding structure of a

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group of pictures represented by the digital picture signal and further identifies each respective picture within said group of pictures.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Chang (5,532,746) discloses a bit allocation method for controlling transmission rate of video recorder.

Ng et al. (5,212,549) discloses an error concealment apparatus for a compressed video signal processing system.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luanne Din whose telephone number is (703) 306-2743.

TOMMY P. OHIN
SUPERVISORY PATENT EXAMINER
GROUP 2600

LPD
August 19, 1996